

Remarks:

The above amendments and these remarks are responsive to the Office action dated May 7, 2004. Claims 1-23 are pending in the application. In the Office action, claims 1-8, 14-15, and 21-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Microsoft Word ("MS Word") screen shots pages 1-5. Claims 9-13 and 16-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over MS Word in view of U.S. Patent No. 6,628,311 B1 to Fang ("Fang"). Claim 2 has been amended to correct typographical errors.

Objection to the Specification

Applicants initially note that the Examiner has identified a typographical error on page 1, line 7 of the specification. Applicants have amended the specification to make appropriate correction.

Rejections under 35 USC § 103

As noted above, claims 1-8, 14-15, and 21-23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Microsoft Word ("MS Word," screen shots 1-5). Claims 9-13 and 16-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the MS Word screen shots in view of Fang (US 6,628,311).

As understood, MS Word (1999 version) is word-processing program having a first Help menu with a "What's This?" tool. Upon selection of the "What's This?" tool, an icon may be identified by passing a cursor over the icon, and the function performed by that icon may be identified in a pop-up window. It is not clear from the MS Word screen shots whether the icon is identified by a mouse-click, or simple placement of the cursor over the icon. It also is unclear from the MS Word screen shots whether the icon functions are disabled upon selection of the "What's This?" tool, or possibly still effected

by mouse-click, double-mouse-click, etc. In any event, it is clear that the "What's This?" tool depicted in the MS Word screen shots does not provide a link to instructions related to accomplishing the function. This fact is expressly recognized by the Examiner on page 2, paragraph 3 of the present Office action.

The MS Word screen shots also disclose a second Help menu, which may be selected to access a Table of Contents (TOC) tool, which presents a list of topics for which help are available. Upon selection of one of a topic from the list, instructions apparently are provided in a corresponding pop-up window. It is not clear from the MS Word screen shots whether such instructions are in any way related to the icons identifiable via the "What's This tool, or whether such instructions relate to any type of function associated with such icons.

Referring initially to claim 1, it is noted that claim 1 recites a method for accessing instructions on a device having a user interface. The claimed method includes "receiving a user-selection of a first help mode displayed on the user interface, the selected first help mode allowing the user to choose an icon for identification of a function associated with the icon without invoking the function," and upon receiving a user-selection of the icon, displaying a help window including an identification of a function associated with the icon and a link to instructions related to accomplishing the function." The claimed method also includes "in response to user-selection of the link, displaying the instructions related to accomplishing the function."

As already recognized by the Examiner, the MS Word screen shots do not disclose "a help window including an identification of a function associated with the icon and a link to instructions related to accomplishing the function." Applicants also

assert that the MS Word screen shots do not disclose instructions related to accomplishing the function associated with a selected icon. Furthermore, applicants assert that there is no suggestion or motivation expressed in the cited art to make modifications to relate the different help operations. The rejection of claim 1 under 35 U.S.C. § 103(a) thus should be withdrawn. The rejection of claims 2-5, which depend from claim 1, also should be withdrawn.

To establish a *prima facie* case of obviousness, all claim features must be taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). Furthermore, "[i]t is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle*, 119 F.3d 953, 957 (Fed. Cir. 1997). The teaching or suggestion must be found in the prior art, and not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1988).

In rejecting claim 1, the Examiner acknowledges that the "What's This?" tool illustrated in the MS Word screen shots does not include a link to instructions related to accomplishing the function associated with the icon. However, the Examiner asserts that it would be obvious to modify the MS Word "What's This? Tool to provide such a link. The Examiner indicates that motivation for such a modification would be "to reduce the number of steps required to access help information." Applicants assert, however, that such motivation is not found in the cited art, but rather in applicants' own disclosure. The proposed modification thus is improper, and the rejection of claim 1 should be withdrawn.

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Furthermore, even if the "What's This? Tool and the TOC tool were combined in a single help window (as the Examiner apparently suggests, but applicant maintains is improper), such combination would not result in a one-to-one relationship between 1) identification of a function associated with an icon, and 2) instructions related to accomplishing the function associated with the icon. Rather, it seems that a list of topics for which help is available would be accessible from a specific identification of a function associated with an icon. Moreover, it is not even clear that the topics in the TOC tool of the MS Word screen shots correlate to the selectable icons, or the functions associated therewith. For these reasons also, the rejection of claim 1 should be withdrawn.

In rejecting claims 6, 14 and 21, the Examiner indicates that they are similar in scope to claim 1, and are therefore rejected under similar rationale. While it is true that each of these claims recite a help window including an identification of a function associated with the selected icon and a link to instructions related to the function associated with the selected icon, and thus that they each are distinguishable from the MS Word screen shots, applicants note that the claims are, in fact, different, and thus worthy of separate treatment.

Claim 6 recites a device configured to perform one or more user-selectable functions, wherein the device includes a user interface with plural selectable icons, "selection of each icon nominally effecting transmission of a corresponding command to the processor" and a help menu with a user-selectable first help mode "which provides for subsequent selection of icons without transmission of the corresponding command to the processor." The cited MS Word screen shots do not disclose such differing effects of "selection" of an icon before or after selection of a

first help mode. In particular, it is understood that the indicated "What's This?" tool identifies an icon simply by passing a cursor over the icon, while "selection" of the function is accomplished by a mouse-click while the cursor is over the icon. MS Word gives no indication that selection of the icon is disabled upon selecting the "What's This?" help mode. The rejection of claim 6 thus also should be withdrawn for this additional reason. Claims 7-13 depend from claim 6, and thus are allowable for at least the same reasons as claim 6.

Claim 14 recites "plural icons, each nominally selectable to invoke a function associated with the icon," and a first help mode which provides for "subsequent selection of one of the icons without invoking the function associated with the selected icon." MS Word gives no indication that selection of the icon is disabled upon selecting the "What's This?" help mode. The rejection of claim 14 thus should be withdrawn for at least this additional reason. Claims 15-20 depend from claim 14, and thus are allowable for at least the same reasons as claim 14.

Claims 21 recites "displaying a help window including an identification of a function associated with the icon and a link to instructions related to accomplishing the function." As noted with respect to claim 1, MS Word does not disclose display of such a help window, and does not suggest any modification of MS Word to achieve display of such a help window. The rejection of claim 23 thus should be withdrawn. Claims 22 and 23 depend from claim 21 and thus are allowable for at least the same reasons as claim 21.

Regarding claim 8, which recites the user interface including a touch screen, applicants note the Examiner's recognition that MS Word does not show such a touch screen. The Examiner indicates, however, that "use of a touch screen is notoriously well known in the art." He does not, however, provide any reference as to such. MPEP 2144.03 states that:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. (emphasis added).

Applicants are not aware of any use of touch screens to accommodate selection of an icon for identification of an associated function in a help menu. As should be apparent, this use of touch screen technology has a particular benefit in the context of copiers, printers, fax machines, etc. as described herein. This benefit is nowhere recognized in the MS Word screen shots, which expressly show use of a cursor, presumably controlled by a mouse. For at least this additional reasons, claim 8 is allowable, and the rejection under 35 U.S.C. 103(a) should be withdrawn.

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Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

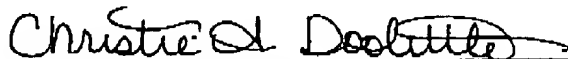
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Examiner G. Jordan, Group Art Unit 2174, Assistant Commissioner for Patents, at facsimile number (703) 872-9306 on August 3, 2004.



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